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1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 *Ex parte* DR. MICHAEL A. MASINI
11

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13 Appeal 2008-4427
14 Application 10/706,570
15 Technology Centger 3700
16

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18 Oral Hearing Held: December 11, 2008
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21 Before DEMETRA MILLS, RICHARD M. LEOVITZ, JEFFREY N.
22 FREDMAN, *Administrative Patent Judges*.
23

24 ON BEHALF OF THE APPELLANT:
25

26 JOHN POSA, ESQ.
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32 The above-entitled matter came on for hearing on Thursday,
33 December 11, 2008, commencing at 1:00 p.m., at the U.S. Patent and
34 Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room A,
35 Alexandria, Virginia, before Laurie B. Allen.

PROCEEDINGS

JUDGE MILLS: If you wouldn't mind, if you could please identify yourself and who you are with, and if you could spell your name for the court reporter.

MR. POSA: Sure thing. And we'd like to start out by thanking you for hosting us here at the Patent Office. We really appreciate it.

I'm John Posa, counsel in this case. I'm with the law firm of Gifford Krass. And to my right is Dr. Michael Masini. He is the inventor in this case, so I assume that's all right to have him here.

JUDGE MILLS: Yes, that's fine.

MR. POSA: All right. So we are on the record now?

JUDGE MILLS: Yes.

MR. POSA: All right. Dr. Masini has brought with him -- hopefully, you'll enjoy this -- some mock-ups. We're talking about bandages here, and Dr. Masini, his invention is actually directed towards something that he is in the process of commercializing. So he has some mock-ups of the invention as claimed, actually, and he also has a version of the Etheredge article. And with your permission, he'd like to show you how the two work, just for background purposes before we get started on the merits, if that's all right.

JUDGE MILLS: Okay. That would be fine, just as long as it's within the 20-minute period we have for the hearing today.

MR. POSA: All right, yes; understood. Thank you.

[Video slide presentation.]

Can you see this? We have a document, and here would be just a

1 standard bandage like the normal bandage with packaging. When you open
2 it up you'd have the traditional bandage with the backing or the release
3 layers in the back. So this is just a traditional bandage that we're all very
4 familiar with for many years, just the traditional bandage with its two sheets
5 as backing. And then I made a mock-up of the Etheredge patent. It's
6 essentially kind of a unique patent. It has several elements to it to make a
7 smaller bandage, so there would be less material, but also to improve a
8 method to apply to a finger.

9 So, first thing, if you look at his figure 3 in the Etheredge patent, you
10 see basically a traditional bandage. And he says that he uses a usual
11 bandage, usual materials, and he basically folds both ends on themselves like
12 this to decrease the amount of, if you will, volume that's going to go in the
13 package. So he essentially has made it smaller, about the third of the size of
14 a traditional bandage. And then he puts it in the packaging, so here I have
15 the bandage that Etheredge has in the packaging, and he also puts an
16 adhesive between the backing layer and the outer packaging, so that as you
17 open it, you then expose the bandage with the adhesive in one portion and he
18 wants you then to apply it to a finger and then pull the ends apart so that as
19 you pull one end around and then the other one you can just pull the
20 releasing and wrap it around the finger in that fashion.

21 So this is the Etheredge concept. I do want to point out that in his
22 figure 4, though, the packaging is already separated from the backing layer.
23 So what this is, drawings 38 and 40 are the backing layers, and 12 and 22
24 would be the packaging. But, before he actually applies it, he's actually
25 separated the backing from the packaging. My concept, however, involves

1 essentially where the packaging itself is the backing layer so that you can
2 simply pull it apart here so that the backing, if you will, this part of the
3 packaging, apply it to your hand like such, and then simply pull it off.

4 I came up with the concept because basically by doing so in surgery at
5 the end of the case it's very difficult using gloves to grab on to adhesive
6 tapes or adhesive bandages. So basically it was thought that by using the
7 packaging as such, a nurse or an assistant could then apply the bandage, and
8 you wouldn't have to as a surgeon touch any of the adhesive portions with
9 your gloves. So that's the essence of my invention.

10 Any questions about that?

11 JUDGE MILLS: No. I believe we understand the concept. Thank
12 you for showing us.

13 MR. POSA: Okay. Sure. You could see us again?

14 JUDGE MILLS: Yes.

15 MR. POSA: Is that correct?

16 JUDGE FREDMAN: Yes.

17 [Slide.]

18 MR. POSA: Okay. Now, with regard to the status of the application
19 we argue two groups of claims. We labeled them A and B. The first group
20 has to do with a 102 rejection over Etheredge and the second group actually
21 involves more than one rejection, but I grouped them together for reasons
22 that we'll get into. With regard to the first grouping it's only three claims
23 and they're based upon claim 11, the independent claim. And this claim
24 unambiguously sets forth that we have first and second removable sheets as
25 you just saw. This is packaging for a bandage having an absorbent layer

1 that's completely surrounded by an adhesive that happens to be in the
2 preamble. I understand that.

3 First and second removable sheets, both extending beyond the
4 peripheral edge of the bandage and peripherally joined. I don't know if you
5 saw that or not, but they are peripherally joined so that the bandage is
6 contained in between these. And then wherein one of these two sheets is in
7 direct contact with the entire adhesive on the patient contacting surface until
8 that sheet is removed. And we're talking about anticipation here, okay, and
9 the claim's rejected over Etheredge.

10 It's our position that the examiner's interpretation of sheet is
11 unreasonable in the sense that the examiner comes right out and states in the
12 examiner's answer, for example, that the two sheets of Etheredge can be
13 considered a single sheet, and it's our position that that's just not the case and
14 that there are two sheets and none of them qualify as being a single sheet in
15 contact with the entire adhesive on the one side. What she's saying is sheets
16 12 and 38, for example, in figure 2 of the Etheredge patent --

17 JUDGE FREDMAN: She's saying it's a single sheet. I think we
18 understand that.

19 MR. POSA: Yes, that's right. First of all, they're temporarily joined
20 along this adhesive 42, which as Dr. Masini pointed out pulls away, actually,
21 quite early on in the application process. But apart from that the idea that
22 two sheets make one is simply not the case. Even if these two sheets were
23 entirely bonded to one another in their entirety, I don't think you could make
24 the argument that two sheets make a single sheet. I mean, we're out of paper
25 here.

1 JUDGE FREDMAN: I think we probably understand what you're
2 saying. But can I ask you a question? Can we look at the Bush reference for
3 a second?

4 MR. POSA: Sure.

5 JUDGE FREDMAN: Do you have it in front of you?

6 MR. POSA: Not yet. No. The very old one?

7 JUDGE FREDMAN: Yeah, uh-huh, the very old reference at,
8 particularly figure 6, and then also at the end of it in column one. So, near
9 the end of column one and then lines sort of 62 and onward, Bush states that
10 the adhesive bandage packaging that comprises an adhesive bandage which
11 includes an adhesive tape and strip. Okay, and the wrapper for the adhesive
12 tape includes a sheet of flexible material adhesively attached to the adhesive
13 side of the adhesive tape can serve not only as a wrapper sheet but also as a
14 protective backing therefore.

15 So it's the last concept that I'm concerned with, and in Bush's
16 disclosed embodiment, he pretty much always seems to have this, I don't
17 know what you call it.

18 JUDGE MILLS: The tab?

19 JUDGE FREDMAN: The tab, I guess, the finger tab to rip it away.
20 But my concern is could you explain why that wouldn't be obvious to just
21 simply make it without the finger tab?

22 MR. POSA: Well.

23 JUDGE FREDMAN: I realize this is a new issue you weren't
24 prepared for.

1 MR. POSA: Correct. We were talking about anticipation over an
2 entirely different reference.

3 JUDGE FREDMAN: Absolutely.

4 MR. POSA: So, I'm a little bit --

5 DR. MASINI: I could perhaps speak to the fact if you saw the idea
6 that I had was again that a separate person could open the package and then
7 apply it to the skin. If you look at figure 5 as it separated before you
8 grabbed the separate tab, once they've opened the package, then they have to
9 grab that separate tab 30 on the side. And I think it's figure 6 there as well,
10 so you couldn't just open the packaging and apply it directly to the patient I
11 think in their drawing there that I just showed you.

12 JUDGE FREDMAN: So in terms of the obviousness question, okay?
13 And it would be nice if I had more time than a few seconds to think about it.
14 We might have argued this in the record already. I'm not certain, but to
15 address your question, this is the way that the Bush system operates. I
16 remember reading this patent, and he wants that little tab. It serves a
17 purpose. You could argue that it serves an important purpose as far as the
18 Bush system is concerned. He talks about it, makes a big deal out of it. It
19 appears to be a point of novelty. I guess my position is that it would
20 undermine the principle of operation of this reference, thereby defeating
21 prima facie obviousness.

22 And the other concern I have is if you look at your claim 15 you also
23 say one of the first and second removable sheets include the dog-eared tab to
24 assist in removal. So that dependent claim seems to have a tab similar to the
25 one in Bush.

1 MR. POSA: Well, no. That's not on a separate. That's one of the two
2 sheets has a place where you can pull it apart from the other sheet. That is
3 not a separate piece of material, like in the case of Bush.

4 DR. MASINI: That would be like in Figure 3, 28 and 27, just to
5 separate the entire packaging but not the separate piece 30, once the original
6 packaging was opened.

7 MR. POSA: Right. It doesn't undermine the idea of only two sheets;
8 nor does it undermine the idea of peripherally joined.

9 JUDGE FREDMAN: Okay.

10 MR. POSA: Okay? I mean, they still completely contain the
11 bandage. And, so again just to address your question, Bush is all about this
12 little tab. And I guess my argument would be that it would undermine the
13 principle of operation of that device.

14 JUDGE LEBOVITZ: And, Dr. Masini, what your point was that in
15 figure 6 it shows after you've opened it actually grasping the tab, so grasping
16 adhesive so you would want the tab there. Do they remove the tab after they
17 apply it?

18 DR. MASINI: In my application you would just basically turn the
19 packaging over and put it directly onto the patient. You wouldn't have to
20 grab the tab to apply it. Like I showed with mine, I just separate the two and
21 put it directly on the patient without having to take a hand then onto the
22 sterile bandage, grab the tab and then pull it apart. Once you reach a hand in
23 on a tab like that, then the sterility is compromised.

24 JUDGE LEBOVITZ: And you also have claim 27 which is a method
25 based on 16. Is that pending?

1 DR. MASINI: Correct, yeah.

2 MR. POSA: Correct. But if your point is that the tab is somewhat
3 necessary to avoid touching an adhesive that will touch the patient, your
4 point is well taken. Now, the second group of claims are pretty interesting.
5 These have to do with consisting of claims. I don't use them very often, but
6 in this case since the article really at one point of novelty is to have as few
7 components as possible to throw away less, etcetera. We put some
8 consisting of claims in here.

9 Now, if you look at claim 16, for example, the examiner's argument is
10 that although it's a consisting of claim, it's not consisting essentially of. It's a
11 consisting of claim. Although it's a consisting of claim there is a word in the
12 claim including. Now, as I understand the examiner's argument, while
13 consisting might close the claim the use of the word including opens it back
14 up again, I think. You know, and similarly with claim 28, the other
15 independent claim, it's a consisting of claim, but it uses words like with and
16 including as well.

17 I disagree with the examiner. I see the examiner's point, all right?
18 And she references some case law, and actually for the Court of Appeals for
19 the Federal Circuit, this is the Mannesmann case. We distinguish over that.
20 There's a statement in here. They agreed with the district court that because
21 the word "consisting of" is in the body of the claim it only limits the element
22 to which that "consisting of" refers. And they come right out and say, had
23 they put it in the preamble it would have been a different situation. Well, we
24 put it in the preamble. Okay, and both cases, a bandage construction
25 consisting of; and in claim 28 a bandage constructing consisting of.

1 JUDGE FREDMAN: You're even consistent with Bush, too.

2 MR. POSA: Yes, okay. So this word, "included," all right? I don't
3 think that opens anything up. That's a descriptive term. All that's saying is
4 what the bandage portion is made up of: first and second removable sheets
5 and only first and second removable sheets, as a mental exercise. All right?
6 And the examiner focuses on the word "including" as being equivalent to the
7 word "comprising" for example, but what if the word "including" were the
8 word "with" or what if it were a word like having or being, or, you know,
9 packaging portion in and of itself has no meaning whatsoever. This element
10 is the same as if the claim were to read simply, "first and second removable
11 sheets."

12 Packaging portion is really only there to name something that we later
13 describe as having first and second removable sheets. There's no evidence
14 whatsoever in this claim that it could have anything else but those.

15 JUDGE LEBOVITZ: Excuse me, but why is the term "consisting"
16 necessary? Are you trying to distinguish over what reference?

17 MR. POSA: Well, I don't remember exactly which reference, but it
18 distinguishes over all the references cited. If you look at Etheredge,
19 certainly, it distinguishes over Etheredge. I mean there's four sheets there,
20 all right? And they're necessary for the operation of that invention and you
21 saw Dr. Masini give you a little demonstration. It distinguishes over Bush. I
22 mean, Bush has this necessary tab "consisting of" claim, distinguishes over.
23 They have arguably I guess three pieces of material that have to be removed
24 and discarded. So when you have a consisting of claim that sets

1 forth only first and second, it distinguishes over that and all of the other art
2 cited.

3 JUDGE LEBOVITZ: Well, in claim 11 as I understood the last clause
4 wherein the sheet is in direct contact with the entire adhesive, that
5 distinguished over the Etheredge reference. Is that limitation in claim 16?
6 I'm just trying to find it, that limitation.

7 MR. POSA: Excuse me.

8 DR. MASINI: It's the limitation in claim 16 the wherein, the direct
9 contact? No.

10 MR. POSA: No. It's not necessary, that claim 16 being a consisting
11 of claim. We all know that's a very limited thing to do, so, no. I mean that
12 particular limitation is not in there, but it's a consisting of claim, was
13 consisting of being in the preamble.

14 JUDGE LEBOVITZ: So you want us to read the claim to have only
15 those elements that follow "consisting of?"

16 MR. POSA: Correct.

17 DR. MASINI: Correct.

18 MR. POSA: And closed in the sense that -- and there's a lot of case
19 law in this I'm sure you're familiar with it -- but closed in the sense that
20 other elements in the prior art, which are related to this type of invention, but
21 which are necessary to carry out those prior art devices, would not read out
22 in this claim because it's closed in that sense.

23 The cases I've read there is some leeway for another device including
24 a prior art device to have an additional element, which is entirely unrelated
25 to the structure or the operation of the claimed article. But in this case and

1 in the case of Etheredge and Bush, those additional sheets, if you will, are
2 directly related to bandages and in fact directly related to the way in which
3 those prior art devices operate and the way in which they are applied.

4 JUDGE LEBOVITZ: I mean if we were to look at the specification,
5 we give claims their broadest reasonable interpretation in view of the spec.
6 I'm not asking you to point to where in the spec. I'm just saying if we were
7 to read the spec.

8 DR. MASINI: It is in the spec.

9 MR. POSA: I'd be happy to. And as a matter of fact, in our appeal
10 brief on page 3, you'll notice that I've included a drawing from the spec for
11 that very reason. If you look at this drawing apart from the person pulling
12 the two sheets apart, all you have shown here is a bandage on the inside
13 having an adhesive area 18, which is described in the spec. Part of those
14 patient contacting surface and the absorbent layer 16. So I claim we have
15 clear support both for the "comprising" claim 11 as well as the "consisting
16 of" claims.

17 JUDGE MILLS: Okay. I think we understand your position with
18 regard to the case. Did you have any final comments? We have about two
19 minutes, if you'd like to wrap it up.

20 MR. POSA: I don't think so. I don't think so. If you have any further
21 questions we'd be happy to answer them.

22 JUDGE MILLS: No more questions here. Thank you very much for
23 your time. Would you be able to tell your names for the court reporter
24 please?

25 MR. POSA: Yes, certainly. My name is Posa, P-o-s-a.

1 DR. MASINI: My name is Michael Masini, M-a-s-i-n-i.

2 JUDGE MILLS: Okay. Thank you very much.

3 MR. POSA: Thank you very much.

4 DR. MASINI: Thank you.

5 [The hearing was concluded at 1:20 p.m.]

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